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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TAYLOR, NICHOLAS R

ART UNIT PAPER NUMBER

2141

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/771,746

Applicant(s)

FISHER, CLAY

Examiner

Nicholas R. Taylor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-30 have been presented for examination and are rejected.

Response to Arguments

2. Applicant's arguments filed 10/13/2005 have been fully considered but they are deemed not persuasive.

3. Prior to discussing the remarks, the Examiner would like to clarify that in the rejections cited references applied to all the preceding unreferenced limitations. For example, in the rejections of claims 1 and 16 the citation "(Hallam-Baker, paragraphs 0008 and 0009)" refers to all three of the limitations preceding it. This is done for clarity and conciseness in the text of the rejections; the Examiner did not overlook any elements in the independent claims.

In the remarks, applicant argued in substance that:

(A) Prior art of Hallam-Baker fails to teach detecting an originating server associated with the electronic message and checking the trustworthy status of the originating server (as it teaches merely checking the data being sent).

As to point (A), Hallam-Baker teaches detecting an originating server associated with the electronic message in both paragraphs 0008-0009 and figure 1. In figure 1, looking at "Message A", the Receiver intercepts a message from Sender A. The

Receiver “detects” the originating server through the sending of an email by which the originator of the message is specified.

While the Examiner concedes that the credential and certificates can be verified in Hallam-Baker, the authentication of these elements is a step in the process of determining the trustworthy status of the originating server. A message is first verified as authentic to “detect a false source address in an e-mail message” (paragraph 0009, last sentence), and it is then assigned a trustworthiness or “desirability level” that the recipient or referee can base their corresponding actions on (paragraph 0010).

The Applicant further argues that the reference has been misapplied as the systems produce a similar result yet achieves this through dissimilar methods. Hallam-Baker teaches a system that takes a message and assigns a status to it based on the identification of the originating server (paragraph 0008, first 5 sentences). One method used to accomplish this includes the sender’s identifying certificate (paragraph 0009). The Applicant’s specification discloses determining “the identity of the originating server through a digital certificate that is transmitted with the electronic message” (specification, page 9, lines 16-23). The inclusion of an identifying certificate is one of the many similarities between the teachings in their shared attempt to solve the problem of unwanted spam sent by unverified sources (background section in both Hallam-Baker and Applicant’s specification).

(B) Prior art of Hallam-Baker fails to teach detecting receipt of the message, detecting the originating server, etc. Hallam-Baker further fails to teach newly amended

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clarification containing the phrase "which has been confirmed as the sender of the electronic message."

As to point (B), the first portion of these arguments are discussed in the response to point (A) above. The Examiner further disagrees that the newly amended clarification teaches away from Hallam-Baker. Hallam-Baker teaches confirmation of the sender of the electronic message primarily through the use of a Certification Authority that verifies the sender through techniques including forwarding the sender's public key and waiting for an acknowledgement of its authenticity (paragraph 0008).

(C) The Examiner failed to interpret the "means" language of claim 16 in light of the specification, as required by the court's holding in *In re Donaldson* and paragraph six of 35 USC § 112.

As to point (C), the Examiner considered the prior art of Hallam-Baker in light of the Applicant's specification through the use of "means plus function elements" in claim 16. The Applicant's specification was used to provide a "reasonable interpretation" of the meaning of the claim elements. These elements and their interrelation to the prior art of Hallam-Baker are discussed in the response to point (A) above and in the citations in the original office action.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-8 and 10-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Hallam-Baker (US PGPub 2004/0205135.)

6. As per claims 1 and 16, Hallam-Baker teaches a method comprising:

detecting receipt of an electronic message;

detecting an originating server associated with the electronic message;

confirming with the originating server that the originating server sent the electronic message;

determining a trustworthy status of the originating server; and (Hallam-Baker, paragraphs 0008 and 0009)

selectively presenting the electronic message to a recipient device based on the trustworthy status of the originating server (Hallam-Baker, paragraph 0023.)

7. As per claim 2, Hallam-Baker teaches the system further wherein the electronic message includes text (Hallam-Baker, paragraph 0008 in the use of the e-mail format.)

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8. As per claim 3, Hallam-Baker teaches the system further wherein the electronic message includes graphics (Hallam-Baker, paragraph 0008 in the use of the e-mail format.)

9. As per claim 4, Hallam-Baker teaches the system further wherein the electronic message includes an identifier that uniquely identifies the originating server (Hallam-Baker, paragraph 0009.)

10. As per claim 5, Hallam-Baker teaches the system further wherein the electronic message includes a digital certificate that uniquely identifies the originating server (Hallam-Baker, paragraph 0008.)

11. As per claim 6, Hallam-Baker teaches the system further comprising updating the trustworthy status of the originating server based on third party ratings of the originating server (Hallam-Baker, paragraph 0014.)

12. As per claim 7, Hallam-Baker teaches the system further comprising updating the trustworthy status of the originating server based on feedback from the recipient device (Hallam-Baker, paragraph 0014.)

13. As per claim 8, Hallam-Baker teaches the system further wherein selectively presenting further comprises selectively displaying the electronic message on the

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recipient device based on the trustworthy status of the originating server (Hallam-Baker, paragraph 0023.)

14. As per claim 10, Hallam-Baker teaches the system further comprising storing the trustworthy status within a storage device (Hallam-Baker, paragraph 0022.)

15. As per claim 11, Hallam-Baker teaches the system further comprising searching for the trustworthy status of the originating server (Hallam-Baker, paragraph 0021.)

16. As per claim 12, Hallam-Baker teaches the system further wherein the recipient device is a computer (Hallam-Baker, paragraph 0051.)

17. As per claim 13, Hallam-Baker teaches the system further wherein the recipient device is a cellular phone (Hallam-Baker, paragraphs 0035 and 0051.)

18. As per claim 14, Hallam-Baker teaches the system further wherein the recipient device is a personal digital assistant (Hallam-Baker, paragraph 0051.)

19. As per claim 15, Hallam-Baker teaches the system further wherein selectively presenting further comprises selectively transmitting the electronic message on the recipient device based on the trustworthy status of the originating server (Hallam-Baker, paragraph 0023.)

20. As per claims 17, 26, and 30, Hallam-Baker teaches a method comprising:
- detecting receipt of an electronic message;
 - detecting an originating server associated with the electronic message;
 - confirming with the originating server that the originating server sent the electronic message;
 - matching an identity of the originating server, which has been confirmed as the sender of the electronic message, with a record that contains information regarding the originating server; and (Hallam-Baker, paragraphs 0008 and 0009)
 - selectively delivering the electronic message to a recipient based on information contained within the record (Hallam-Baker, paragraph 0023.)
21. As per claim 18, Hallam-Baker teaches the system further wherein matching further comprises matching the recipient of the electronic message with a recipient identity of the record (Hallam-Baker, paragraph 0014.)
22. As per claims 19 and 27, Hallam-Baker teaches the system further wherein the information within the record includes a trustworthy status of the originating server (Hallam-Baker, paragraph 0014.)

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23. As per claim 20, Hallam-Baker teaches the system further wherein the information within the record includes a third party rating of the originating server (Hallam-Baker, paragraph 0014.)

24. As per claim 21, Hallam-Baker teaches the system further wherein the information within the record includes a recipient request of the originating server (Hallam-Baker, paragraphs 0014-0015 and 0023.)

25. As per claim 22, Hallam-Baker teaches the system further comprising forming a new record including an identity information of the originating server and the recipient (Hallam-Baker, paragraphs 0014-0015 and 0023.)

26. As per claim 23, Hallam-Baker teaches the system further wherein the new record further includes the trustworthy status of the originating server (Hallam-Baker, paragraph 0014.)

27. As per claims 24 and 28, Hallam-Baker teaches the system further comprising selectively delivering the electronic message to a device operated by the recipient based on the trustworthy status (Hallam-Baker, paragraph 0023.)

28. As per claim 25, Hallam-Baker teaches the system further comprising selectively displaying the electronic message on a device operated by the recipient based on the trustworthy status (Hallam-Baker, paragraph 0023.)

29. As per claim 29, Hallam-Baker teaches the system further comprising an interface module for transmitting the information to the device (Hallam-Baker, paragraph 0014.)

Claim Rejections - 35 USC § 103

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hallam-Baker (US PGPub 2004/0205135) and Wang et al. (US PGPub 2004/0203589.)

32. As per claim 9, Hallam-Baker teaches the above yet fails to teach assigning a digital certificate to the originating device.

Wang teaches assigning digital certificates to sending devices in a trusted email system (Wang, paragraphs 0018 and 0022.) It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Hallam-Baker and Wang to provide the trusted certificate system of Wang in the system of

Hallam-Baker, because doing so would provide an effective way of managing junk messages (Wang, paragraph 0006.)

Conclusion

33. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-3889. The examiner can normally be reached on Monday-Friday, 8:00am to 5:30pm, with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas Taylor
Examiner
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